

Application Serial No. 09/641,101  
Attorney Docket No. 935-007.3

# I. Claim Rejections Under 35 USC §251

Applicants point out that the claims as copied from the '890 patent cover three distinct embodiments of inserts for controlling valve characteristics - namely, one group directed to an insert which fits within and is secured to a valve body for a ball valve, a second group directed to an insert which fits within and is secured to a ball for a ball valve and a third group wherein an insert is part of a valve seat.

Applicants' patented claims relate to valves having specific arrangements for seating a valve body insert in the valve body, and all of those original claims (Claims 1-9) are again indicated as being allowable.

In addition, applicants' disclosure fully supports all claims of the '890 patent relating to inserts which fit within and are secured to a valve body for a ball valve and those which are generic to claims of this group. The reissue claims in this group, including generic claims, are (with reference to '890 claims):

## (i) Inserts Which Fit Within And Are Secured To A Valve Body

Application Claims	'890 Claims
18	9
21	12
22	13
23	14
24	15
25	16
26	17
28	19
29	20
33	24
34	25
36	27
37	28

Applicants believe that the claims of the other two groups are supported, to the extent based on material limitations, by applicants' disclosure. Each of the examiner's points will be specifically addressed

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following the listing of the remaining two groups of claims. The first listed group includes the claims wherein an insert is attached to a valve ball or like member and the second includes the claims wherein a like insert is associated with a valve seat.

(ii) An Insert Is Attached To A Valve Ball Or Like Member

Application Claims	'890 Claims
10-17	1-8
19	10
27	18
30	21
32	23
41	32
42	33

(iii) Insert Is Associated With A Valve Seat

Application Claims	'890 Claims
20	11
31	22
35	26
38	29
39	30
40	31

A. Claims 10-17, 19, 20, 22 and 24 through 42 Stand Rejected for Lack of Support

The Office Action lists points i) through ix) which are said to be unsupported added material. These are addressed below.

- i) "the connector on the insert member" - see Figure 8 and the flange (unnumbered) on disk 8. while not the sole connector and used in conjunction with another means, it is equivalent in its function as a connector with the embodiment of Fig. 6 of the '890 patent wherein

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- element 318 relies on external means (not shown) for connection.
- ii) "the insert member attached to the valving member" - While not literally shown, is a feature not patentably distinct (and therefore not material) from the embodiment wherein the attachment is to the valve body.
  - iii) "the insert member is attached to the valve seat" - Again, while not literally shown, is a feature not patentably distinct (and therefore not material) from the embodiment wherein the attachment is to the valve body.
  - iv) "the insert member having a parabolic opening" - Applicants' description describes the insert opening being curved to achieve "equal percent" flow characteristics: the same effect achieved by the '890 patent with its "parabolic" opening. The '890 patent does not illustrate a true parabolic curve and in the description indicates that the opening is "parabolic" in that the height *h* of opening 246 changes across its width *w*, unlike the oblong opening 146 which has a substantially constant height. Similar to the oblong opening 146 above, the parabolic opening 246 provides improved volume control over a conventional ball valve, and in particular provides an equal percentage flow characteristic which is preferred in automatic temperature control systems." (col. 7, lines 3-10)
  - v) "the valving member being formed from brass or stainless steel" - Again, these limitations are not material to patentability and are understood by those skilled in the art to be included in any description of valving materials.
  - vi) "the insert members are made of plastic" - Again, these limitations are not material to patentability and are understood by those skilled in the art to be included in any description of valving materials, especially where the disclosure does call for a "semi-resilient material" (col. 5, line 66).
  - vii) "the inserts having a diameter corresponding to the diameter of the bore of the valving member" - In this regard, see Figure 1 of applicants' description, which shows an insert 8 having several diameters, at least one of which has "a diameter corresponding to the diameter of the bore of the valving member".

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- viii) "the valving member and connectors of the insert members comprising cooperating legs and pockets" - Again, these limitations are not material to patentability.
- ix) "a portion of the valve seat extending across the fluid passage and having an elongate opening" - Again, these limitations are not material to patentability.

**B. Claims 18, 21 and 23 Stand Rejected for Improper Recapture**

This rejection is improper for at least the three following reasons:

- (1) The subject claims were never presented previously, and the recapture doctrine does not apply here because the policy reasons for its adoption do not apply;
- (2) The subject claims were allowed in the '890 patent; and
- (3) The narrowing amendments made in applicants' earlier application were made in error, applicants not being aware of the presence and allowance of the subject claims in the application leading to the '890 patent.

The rejection is an improper attempt on the part of the Office to avoid the costly interference procedures. Applicants are very sensitive to the cost issue, but believe that Congress did not want the process easily side stepped by the Office whenever the possibility of entering into an interference depended upon the filing of a broadened reissue.

The reissue statute is to be broadly construed. This is basic and is clearly set out in the case of *Brenner v. The State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968). There, the Office would not permit a reissue to correct a claim of foreign priority, and the court found that Congress established the procedures for reissue to prevent such kinds of injustice. In the present case, the Office is refusing to permit applicants to copy broader patented claims for the purpose of provoking a priority contest as is provided by law. It appears that the Office has again placed form over substance and should permit the claims to be presented in this application so that the remedial provisions of the statute are given force. If the statute were construed liberally, as is proper under the above case, the issue of entitlement to a patent by either applicants or the '890 patentee would be decided in a manner fair to all. To construe the statute

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narrowly, as is set out in the Office Action, would have the effect of the Office placing an imprimatur on the patent even though it has evidence that the patent might not be properly granted to the correct party.

It is noted that MPEP §1449.02 specifically authorizes reissue applications in situations similar to applicants' where it states:

"A reissue application can be employed to provoke an interference if the reissue application:

- (A) adds copied claims which are not present in the original patent;
- (B) amends claims to correspond to those of the patent or application with which an interference is sought; or ..."

Applicants meet both of these criteria. No exceptions are stated for the present case where, the claims are exact copies of patented claims – allowed for reasons not addressed in applicants' original application, but omitting certain limitations added by applicant to obtain patentability of certain claims then present in their file. Such an exception to the above permissible types of reissue situations would in effect deny an applicant to any right to a broadened reissue and would be clearly improper where the statute permits broadened reissues. In the only exception given by this part of the MPEP, an applicant can be prevented from presenting claims intentionally omitted from the patent. However, here, applicants were not aware of the '890 claims and made no effort to omit them from their application.

Applicants note that none of the cases cited by the Office relate to the fact situation herein, wherein the claims rejected for recapture were neither previously presented nor argued. Moreover, the impropriety of applying the recapture provision in the case where the new claims have been copied for the purpose of provoking an interference is even more compelling. Such a rejection is not sanctioned by case law or the Rules of Practice. Accordingly, reconsideration and withdrawal of the rejections based on 35 U.S.C. §251 are believed in order.

### III. Claim Rejections – 35 U.S.C. §112

Claims 10-17, 19, 20, 22 and 24-42 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter that is not described in the specification in accord with the statute. This rejection

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is respectfully traversed for the reasons given above with regard to the rejection made under 35 U.S.C. §251 of these same claims.

#### IV. Claim Rejections - 35 U.S.C. §102

Claims 39 and 40, (Claims 30 and 31 of the '890 Patent) stand rejected Under 35 U.S.C. §102(b) as being anticipated by Scaramucci, U. S. Patent No. 3,542,338.

Applicants traverse the rejection for the reasons as would be apparent from the file of the '890 patent and were otherwise considered by the Office in the determination to grant that patent. If the reasons do not apply to that patent for reasons within the knowledge of the Office but not apparent on the record, applicants have a right to know them under 35 U.S.C. §132. Simply, to properly respond, applicants must be informed of the reasons for the rejection. Failure to supply reasons is improper under 35 U.S.C. §132 and a denial of due process.

As noted, these claims are patented in the '890 patent. The most appropriate way to handle the issue of patentability in this circumstance is for both the patentee of the '890 patent and applicant be given the opportunity to address the issue in an interference proceeding.

Moreover, it is not appropriate for a rejection to be made on prior art against claims copied from the '890 patent without the approval of the Group Director. MPEP §2307.02 states in pertinent part as follows: "If the ground of rejection is also applicable to the corresponding claims in the patent, any letter including the rejection must have the approval of the Group Director." In the present case, such approval has not been obtained and the rejection is contrary to Office policy. Accordingly, such action is not properly made and cannot be made final in the next Office Action.

#### V. Claim Rejections - 35 U.S.C. §103

Claims 18, 21 and 23 through 25, (Claims 9, 12 and 14 through 16 of the '890 Patent) stand rejected Under 35 U.S.C. §103(a) as defining an invention which would have been obvious from Scaramucci, U. S. Patent No. 3,542,338. Applicants traverse this rejection for the reasons given above.

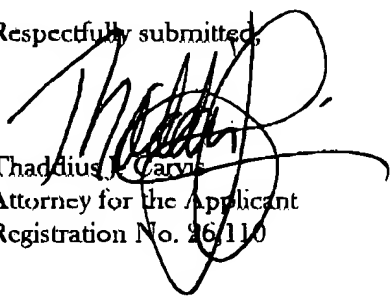
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### Conclusion

Applicants respectfully request reconsideration of Claims 10-42 in light of the above remarks. If any questions remain after reviewing the Applicants' remarks, the Examiner is invited to call the Applicants' attorney of record. Applicants again stress that the above Office Action is not properly made because it includes a rejection of a copied patent claim without proper authorization of the Group Director. Accordingly, any subsequent action repeating this basis for rejection must be non final, giving applicants the full advantages guaranteed by 35 U.S.C. §132.

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